

ESTTA Tracking number: **ESTTA679852**

Filing date: **06/24/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	FERRERO S.P.A.
Granted to Date of previous extension	08/12/2015
Address	Piazzale Pietro Ferrero 1 Alba, Cuneo, 12051 ITALY
Attorney information	LEO M LOUGHLIN ROTHWELL FIGG ERNST & MANBECK PC 607 14TH STREET NW, SUITE 800 WASHINGTON, DC 20005 UNITED STATES PTO-TM-Email@rothwellfigg.com Phone:(202) 783-6040

Applicant Information

Application No	86265346	Publication date	04/14/2015
Opposition Filing Date	06/24/2015	Opposition Period Ends	08/12/2015
Applicant	FERRO Baking Industry Ltd 10 Androutsou Street Aghia Paraskevi, 15341 GREECE		

Goods/Services Affected by Opposition


Class 030. First Use: 1993/01/01 First Use In Commerce: 2002/12/10 All goods and services in the class are opposed, namely: Bakery goods; Bakery goods and dessert items, namely, cakes, cookies, pastries, candies, and frozen confections for retail and wholesale distribution and consumption on or off the premises; Bakery goods, namely, wafer rolls filled or not filled; Bakery products; Biscuits; Breadsticks; Cereal based snack food; Chocolates and chocolate based ready to eat candies and snacks; Confectioneries, namely, snack foods, namely, chocolate; Granola snacks; Multigrain-based snack foods; Petit-beurre biscuits; Savoury and salted biscuits; Snack foods, namely, chocolate-based snack foods; Wafers


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3181623	Application Date	08/10/2004
Registration Date	12/05/2006	Foreign Priority	NONE

		Date	
Word Mark	FERRERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1964/01/01 First Use In Commerce: 1969/00/00 CANDIES, CHOCOLATE CANDIES, SPREAD CONTAINING CHOCOLATE AND NUTS		

U.S. Registration No.	1017527	Application Date	07/22/1974
Registration Date	08/05/1975	Foreign Priority Date	NONE
Word Mark	FERRERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1964/01/01 First Use In Commerce: 1968/03/00 CHOCOLATE CANDY, CHOCOLATE COATED CANDY, [CAKES,] AND CHOCOLATE SPREAD FOR BREAD		

Attachments	78465113#TMSN.png(bytes) 73027373#TMSN.png(bytes) Notice of Opposition and Exhibits.pdf(361835 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Leo M. Loughlin/
Name	LEO M. LOUGHLIN
Date	06/24/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application
Serial No. 86/265,346
Published on April 14, 2015

Ferrero S.p.A.,)	
)	
Opposer.)	Opposition No. _____
)	
v.)	
)	
FERRO Baking Industry Ltd,)	
)	
Applicant.)	

TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22312-1451

NOTICE OF OPPOSITION

Opposer Ferrero, S.p.A., with an address at Piazzale Pietro Ferrero 1, Alba (Cn), I-12051, ITALY, a corporation organized under the laws of Italy, believes that it will be damaged by the registration of the mark FERRO' and Design (hereinafter "Applicant's Mark") as shown below,



which is owned by FERRO Baking Industry Ltd., a company organized under the laws of Greece, with an address at 10 Androutsou Street, Aghia Paraskevi, 15341, Greece (hereinafter "Applicant") for "bakery goods; bakery goods and dessert items, namely, cakes, cookies, pastries, candies, and frozen confections for retail and wholesale distribution and consumption

on or off the premises; bakery goods, namely, wafer rolls filled or not filled; bakery products; biscuits; breadsticks; cereal based snack food; chocolates and chocolate based ready to eat candies and snacks; confectioneries, namely, snack foods, namely, chocolate; granola snacks; multigrain-based snack foods; petit-beurre biscuits; savoury and salted biscuits; snack foods, namely, chocolate-based snack foods; wafers” in Class 30 as set forth in Application Serial No. 86/265,346 filed on April 29, 2014, and published on April 14, 2015, and hereby opposes the same. As grounds for this opposition, it is alleged that:

1. Since long prior to the filing date of the Application Serial No. 86/265,346 and claimed date of first use in commerce, Ferrero has extensively used, advertised and promoted the mark FERRERO for a wide variety of goods and services.

2. Ferrero is the owner and user of the following U.S. registrations for the mark FERRERO, among others:

- Registration No. 3,181,623 registered on December 5, 2006 for FERRERO for “candies, chocolate candies, spread containing chocolate and nuts” in class 30 (**Exhibit A-1**);
- Registration No. 1,017,527 registered on August 5, 1975 for **FERRERO** for “chocolate candy, chocolate coated candy and chocolate spread for bread” in class 30 (**Exhibit A-2**);

3. Each of the above-mentioned registrations is valid, subsisting and incontestable.

Print outs from the electronic database provided by the U.S. Patent and Trademark Office showing current status and title of the registrations listed above are attached as **Exhibit A-1 to A-2** and are incorporated therein by reference and for purpose of reliance.

4. Substantial resources, time and effort have been expended in connection with the promotion of the products, fostering the famous brand, and protecting the FERRERO Mark. As a result of these extensive investments, Ferrero has built up significant recognition in relation to its products offered under the FERRERO Mark, acquiring great value as an identifier of Ferrero's goods and as a way of distinguishing Ferrero's goods from those of others. The FERRERO Mark is well-known and famous throughout the United States as a distinctive symbol of Ferrero's goodwill.

5. On April 29, 2014, Applicant filed U.S. Application Serial No. 86/265,346 for Applicant's Mark for "bakery goods; bakery goods and dessert items, namely, cakes, cookies, pastries, candies, and frozen confections for retail and wholesale distribution and consumption on or off the premises; bakery goods, namely, wafer rolls filled or not filled; bakery products; biscuits; breadsticks; cereal based snack food; chocolates and chocolate based ready to eat candies and snacks; confectioneries, namely, snack foods, namely, chocolate; granola snacks; multigrain-based snack foods; petit-beurre biscuits; savoury and salted biscuits; snack foods, namely, chocolate-based snack foods; wafers" in Class 30.

6. Ferrero's use and registration of its FERRERO Mark in the U.S. predates Applicant's filing of U.S. Application Serial No. 86/265,346 and Applicant's claimed date of first use in commerce.

7. Applicant's Mark is substantially similar in sight, sound and appearance to the famous FERRERO Mark.

8. U.S. Application Serial No. 86/265,346 lists related goods in International Classes 30, the primary class of the FERRERO Mark.

9. Applicant's Mark so closely resembles Ferrero's previously used and registered FERRERO Mark that its use, in connection with the goods aforementioned, is likely to cause confusion, or to cause mistake or deceive, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052 (d). Purchasers likely will assume that Ferrero is somehow affiliated with, licenses, or endorses, Applicant's use of Applicant's Mark when Ferrero is not connected in any way with Applicant or the use of Applicant's Mark.

10. Likelihood of confusion in this case is enhanced by the fame of the FERRERO Mark and, by the fact that consumers associate the mark with the goods sold, approved or endorsed by Ferrero.

11. Applicant is not affiliated or connected with or endorsed or sponsored by Ferrero, nor has Ferrero approved any of the goods offered or sold by Applicant under Applicant's Mark, nor has Ferrero granted Applicant permission to use said mark.

12. The registration of the Applicant's Mark will be inconsistent with Ferrero's rights in the FERRERO Mark, the registrations pleaded above and Ferrero's rights at common law and will be damaging to Ferrero.

13. Use and registration of Applicant's Mark will deprive Ferrero of the ability to protect its reputation and goodwill.

WHEREFORE, Ferrero prays that this opposition be sustained and registration on Application Serial No. 86/265,346 be refused.

Respectfully submitted,

Ferrero S.p.A.

By:



E. Anthony Figg
Leo M. Loughlin
Attorneys for Opposer
Rothwell, Figg, Ernst & Manbeck P.C.
607 14th Street, N.W.
8th Floor
Washington, DC 20005
Phone: 202-783-6040

Date: 6/24, 2015

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION and **Exhibits A-1 and A-2** have been served via First Class Mail, postage prepaid, to the following:

FERRO Baking Industry Ltd.
10 ANDROUTSOU STREET
AGHIA PARASKEVI 15341
GREECE

On this 6/24, 2015.



Leo M. Loughlin

Mark: FERRERO

FERRERO

US Serial Number: 78465113 Application Filing Date: Aug. 10, 2004
US Registration Number: 3181623 Registration Date: Dec. 05, 2006
Register: Principal
Mark Type: Trademark
Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.
Status Date: Feb. 13, 2012
Publication Date: Dec. 06, 2005 Notice of Allowance Date: Feb. 28, 2006

Mark Information

Mark Literal Elements: FERRERO
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
Mark Drawing Type: 4 - STANDARD CHARACTER MARK
Acquired Distinctiveness Claim: In whole

Related Properties Information

Claimed Ownership of US Registrations: 1017527, 1366927, 2785904 and others

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: CANDIES, CHOCOLATE CANDIES, SPREAD CONTAINING CHOCOLATE AND NUTS

International Class(es): 030 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1964

Use in Commerce: 1969

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Ferrero S.p.A.
Owner Address: Piazzale Pietro Ferrero 1
Alba, Cuneo 12051
ITALY
Legal Entity Type: CORPORATION State or Country Where: ITALY

Attorney/Correspondence Information

Attorney of Record	
Attorney Name: Leo M. Loughlin Attorney Primary Email Address: PTO-TM-Email@rfem.com	Docket Number: 1580-973 Attorney Email Authorized: Yes
Correspondent	
Correspondent Name/Address: Leo M. Loughlin Rothwell, Figg, Ernst & Manbeck, pc 607 14th Street NW Suite 800 Washington, DISTRICT OF COLUMBIA 20005 UNITED STATES	
Phone: 202-783-6040 Correspondent e-mail: PTO-TM-Email@rfem.com	Fax: 202-783-6031 Correspondent e-mail Authorized: Yes
Domestic Representative	
Domestic Representative Name: Leo M. Loughlin Phone: 202-783-6040 Fax: 202-783-6031	
Domestic Representative e-mail: PTO-TM-Email@rfem.com	Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Dec. 19, 2014	ATTORNEY REVOKED AND/OR APPOINTED	
Dec. 19, 2014	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Feb. 13, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - MAILED	
Feb. 13, 2012	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76538
Feb. 10, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76538
Dec. 23, 2011	TEAS SECTION 8 & 15 RECEIVED	
Dec. 05, 2006	REGISTERED-PRINCIPAL REGISTER	
Oct. 28, 2006	LAW OFFICE REGISTRATION REVIEW COMPLETED	76529
Oct. 26, 2006	ASSIGNED TO LIE	76529
Oct. 18, 2006	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Oct. 13, 2006	AMENDMENT FROM APPLICANT ENTERED	69712
Oct. 03, 2006	CORRESPONDENCE RECEIVED IN LAW OFFICE	69712
Oct. 03, 2006	PAPER RECEIVED	
Sep. 21, 2006	NON-FINAL ACTION MAILED	
Sep. 21, 2006	SU - NON-FINAL ACTION - WRITTEN	80819
Sep. 19, 2006	STATEMENT OF USE PROCESSING COMPLETE	76569
Aug. 28, 2006	USE AMENDMENT FILED	76569
Aug. 28, 2006	TEAS STATEMENT OF USE RECEIVED	
Feb. 28, 2006	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Dec. 06, 2005	PUBLISHED FOR OPPOSITION	
Nov. 16, 2005	NOTICE OF PUBLICATION	
Oct. 15, 2005	LAW OFFICE PUBLICATION REVIEW COMPLETED	69712
Oct. 07, 2005	ASSIGNED TO LIE	69712
Oct. 03, 2005	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 24, 2005	AMENDMENT FROM APPLICANT ENTERED	69712
Sep. 16, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	69712
Sep. 16, 2005	PAPER RECEIVED	
Mar. 21, 2005	NON-FINAL ACTION MAILED	

Mark: FERRERO

FERRERO

US Serial Number: 73027373
US Registration Number: 1017527
Register: Principal
Mark Type: Trademark
Status: The registration has been renewed.
Status Date: Aug. 19, 2005

Application Filing Date: Jul. 22, 1974
Registration Date: Aug. 05, 1975

Mark Information

Mark Literal Elements: FERRERO
Standard Character Claim: No
Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Related Properties Information

Claimed Ownership of US Registrations: 0870271, 0969715

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *,* identify additional (new) wording in the goods/services.

For: CHOCOLATE CANDY, CHOCOLATE COATED CANDY, [CAKES,] AND CHOCOLATE SPREAD FOR BREAD

International Class(es): 030 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1964

Use In Commerce: Mar. 1968

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: FERRERO S.P.A.
Owner Address: PIAZZALE PIETRO FERRERO
12051 ALBA, CUNEO
ITALY
Legal Entity Type: CORPORATION
State or Country Where Organized: ITALY

Attorney/Correspondence Information

Attorney of Record
Attorney Name: G. FRANKLIN ROTHWELL
Correspondent
Correspondent Name/Address: G FRANKLIN ROTHWELL
ROTHWELL, FIGG, ERNST & KURZ PC
1425 K ST NW STE 800

WASHINGTON, DISTRICT OF COLUMBIA 20005
UNITED STATES

Domestic Representative

Domestic Representative Name: ROTHWELL, FIGG, ERNST & KURZ

Prosecution History

Date	Description	Proceeding Number
Aug. 19, 2005	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Aug. 19, 2005	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Aug. 19, 2005	ASSIGNED TO PARALEGAL	67826
Jun. 28, 2005	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jun. 28, 2005	PAPER RECEIVED	
Oct. 04, 1995	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jul. 14, 1994	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
May 26, 1981	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Aug. 05, 2005

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Feb. 16, 2006

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: P. FERRERO & C. S. P. A.

Assignment 1 of 1

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: [0411/0937](#)

Pages: 4

Date Recorded: Mar. 18, 1982

Supporting Documents: No Supporting Documents Available

Assignor

Name: [P.FERRERO & C.S.P.A.](#)

Execution Date: Sep. 24, 1981

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [FERRERO S.P.A.](#)

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Address: PIAZZALE PIETRO FERRERO
ALBA PROVINCE OF CUENO, ITALY

Correspondent

Correspondent Name: BERNARD, ROTHWELL ET AL.

Correspondent Address: 1700 K ST., N.W.
WASHINGTON, DC 20006
WASHINGTON, DC 20006

Domestic Representative - Not Found

Ferrero S.p.A.'s Exhibits
Opposition to Apn Serial No. 86/265,346
Exhibit A-2, Page 2 of 2